

REMARKS

This application has been carefully reviewed in light of the Office Action dated June 13, 2003. Claims 1-3 remain pending in this application. Claims 1 and 2 are the independent claims. Favorable reconsideration is respectfully requested.

On the merits, the Office Action rejected Claims 1-4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully believe the amendments to Claims 1 and 2 adequately respond to the § 112 rejections. Applicants respectfully request withdrawal of the § 112, second paragraph rejection.

Further on the merits, the Office Action rejected Claims 1 and 4 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in a way to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully submit that at least page 4 lines 20-34 of Applicants' specification describes first, second, and third resistance values in three states (X, Y, Z) which provides adequate description to satisfy § 112, first paragraph. In addition, Claim 4 is withdrawn. Applicants respectfully request withdrawal of the § 112, first paragraph rejection.

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Further on the merits, the Office Action rejected Claim 2 under 35 U.S.C. § 102(b) as being unpatentable over Smith (U.S. Patent No. 3,400,390; hereinafter "Smith"). Applicants respectfully traverse this rejection.

Applicants' Claim 2 recites: "[A]n electronic circuit device comprising: a first and second contact terminal; a first and second switching transistor each with a current channel, the current channels being coupled in parallel between the first and second contact terminal, both for substantially providing a switchable short-circuit between the first and second contact terminal though the main current channels in a normal operating mode; a control circuit, the control circuit being arranged to switch the first and second switching transistors between at least three states, the first and second transistor being switched on and off respectively in the first state and vice versa in the second state, both transistors being switched on in the third state, wherein the switching transistor has only two contact terminals."

As stated in the Office Action, Smith does not mention the tri-state for the first and second switching transistors. The Office Action argues that one could turn on the transistor 30 with a Hi bit signal, turn off transistor 31 with a low bit signal, or turn off the first transistors with a low bit signal... etc. However, Applicants note that However, M.P.E.P. § 706.02(j) states:

To establish a *prima facie* case of obviousness, three

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basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully believe that Smith fails to provide suggestion to modify its device structure to include a control circuit for switching between three states, as well as reasonable expectation of success for performing such a test. The claim that one could modify Smith is insufficient evidence that one of ordinary skill in the art at the time of the invention would have included such a control circuit. Thus the § 103 rejection of Claim 2 fails because no expectation of success exists.

Further, the Office Action's argument that one of ordinary skill in the art at the time of the invention would have been motivated to modify Smith's device because the control can be manually used to perform tri-state measurements cannot be sustained. This is because mere possibilities do not constitute grounds by which an obviousness rejection can be maintained without improper hindsight by "use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," see *In Re Denis*  
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Rouffet, 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998). This improper hindsight indicates an improper means by which to reject a claim.


Claim 2 is believed patentable for at least these reasons.

Claim 3 depends from independent Claim 2 discussed above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 3-4 to be independently patentable and request separate consideration of each claim.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned agent may be reached by telephone at the number given below.

Respectfully submitted,

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